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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

REICHLER, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,375

Applicant(s)

PONOMARENKO ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Inventorship

1. The petition for change of inventorship has been received in the application. However such petition has not granted since the petition does not comply with 37 CFR 1.48, (a)(5) and 37 CFR 3.73(b)(1). Therefore the inventorship remains as originally filed.

Specification

Drawings

2. The drawings are objected to because in Figure 2, 42 should be 26 and 60 should be 10. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

3. The abstract of the disclosure is objected to because legal terminology, i.e. “comprising”, should be avoided. Also does the abstract include more than one paragraph, i.e. is the last line a new paragraph? Abstracts should consist of only a single paragraph. Correction is required. See MPEP § 608.01(b).

4. The use of the trademark spandex (page 9, line 27) and the trademarks on page 14, line 32, page 15, lines 5, 10 and 13-14 and the notes 1-6 on page 19 have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capital letters or with a symbol but not both.

5. The disclosure is objected to because of the following informalities: On page 3, line 24 and page 20, line 23-page 21, line 1, “through” (each) should be --Through--. On page 6, line 15, “surface tension” should be --Surface Tension--. On page 13, lines 8-9, “will be present invention” should be deleted. On page 14, line 13, “with” should be deleted. On page 15, line 4 appears to be missing a word or words. On page 15, line 32, “,” (1st) should be deleted. On page 20, line 27, after “3”, --,-- should be inserted. On page 21, lines 7-8 and 15, “strike-through”

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should be --Strike-Through--. On page 21, the last full paragraph is redundant, see page 3, second full paragraph. Appropriate correction is required.

Claim Language Interpretation

6. The claim language is interpreted in light of the definitions at page 3, line 29-page 4, line 29.

Claim Objections

7. Claims 2-20 are objected to because of the following informalities: in claims 2-14 and 16-20, line 1, "A" should be --The--. In claim 15, line 4, "comprises should be --comprising--. In claim 16, line 3, after "treatment", --,-- should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. Claims 3, 10, 16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 3, is Applicant claiming the substrate is a nonwoven material? If so, a clear antecedent basis for such should be set forth. In regard to claim 10, a positive structural antecedent basis for "said storage layer" should be set forth. In claims 16 and 19-20, is Applicant claiming a step of selecting?

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-9 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Cramer et al '569 or '933 or '957.

See Claim Language Interpretation section supra and '569 at see col. 2, lines 3-6, col. 2, line 17-col. 3, line 4, col. 3, lines 32-49, col. 4, lines 24-30, col. 5, lines 33-63, col. 7, line 28-57, col. 9, line 15-col. 14, line 57, col. 15, lines 7-35, col. 17, lines 26-29, col. 20, line 4-col. 21, line 52, col. 22, lines 32-59, col. 25, lines 23-41, col. 27, lines 20-30 and Table 5, especially the 1st Insult. Therefore, the '569 device clearly includes all the claimed structure and function of the claims except for the Gush results set forth in the definition of "hydrophilicity boosting". Attention is invited to Table 5 and col. 25, lines 33-41 again which appears to set forth results consistent with such definition. In any case, '569 teaches the same compositions of nanoparticles applied to the same substrates in the same manner as that disclosed in the instant application having such "hydrophilicity boosting" capability. Therefore there is sufficient factual evidence for one to conclude that the article of '569 would inherently also have such capability when tested as set forth in the instant application, see MPEP 2112.01.

With regard to '933, see col. 2, lines 3-6, col. 2, line 17-col. 3, line 4, col. 3, lines 32-49, col. 4, lines 24-30, col. 5, lines 33-63, col. 7, line 28-57, col. 9, line 15-col. 14, line 52, col. 15,

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lines 1-30, col. 17, lines 21-24, col. 19, line 65-col. 21, line 45, col. 22, lines 25-52, col. 25, lines 17-35, col. 27, lines 14-24, Table 5, especially the 1st Insult, and the claims and the discussion of '569 which also applies here.

With regard to '957, see paragraphs 9-14, 22, 26, 30-31, 36, 42-71, 75-77, 89, 114-122, 129-130, 140-141, 152, Table 5, especially the 1st Insult, and the claims and the discussion of '569 which also applies here.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

11. Claims 1-9 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rohrbaugh et al '634.

See Claim Language Interpretation section supra and paragraphs 9-14, 22, 26, 30-31, 36, 42-71, 74-76, 88, 113-122, 128-129, 139-140, 151, Table 5, especially the 1st Insult, and the claims and the discussion of '569 which also applies here.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being obvious over Cramer et al ‘569 or ‘933 or ‘957 or Rohrbaugh et al ‘634 in view of Aziz ‘803 and Thompson ‘926.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the

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reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C.

103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2).

Claims 10-11 claim a storage layer of a particular material or a backsheet and a core between the backsheet and the topsheet. Each of the prior art references discloses coating topsheet which forms a portion of a disposable absorbent article which also includes a storage layer or absorbent core but not the specifics of the claims. However, see, for example, Aziz at col. 3, line 42-col. 6, line 2 and Thompson at col. 3, line 52-col. 13, line 26, i.e. storage layers of the claimed materials are well known as are absorbent cores being between topsheets and backsheets. Therefore, to employ a storage layer of the materials claimed in claim 10 and a core between the topsheet and a backsheet as taught by Aziz and Thompson with the disposable absorbent articles of Cramer et al '569 or '933 or '957 or Rohrbaugh et al '634 would be obvious to one of ordinary skill in the art in view of the recognition that it is well known to use such structures in disposable absorbent articles and disposable absorbent articles being disclosed by the prior art to Cramer or Rohrbaugh.

14. Claims 1-6, 10-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisman et al '746 in view of Aziz '803 and Thompson '926.

Claims 1-6, 10-12, 15 and 18-20: See Claim Language Interpretation section supra and '746 at abstract, col. 1, lines 6-20, col. 2, lines 17-23, col. 3, lines 28-35, col. 3, line 67-col. 4, line 44, col. 4, lines 46-62, col. 5, lines 12-15, col. 5, line 34-col. 6, line 43, col. 11, line 62-col. 12, line 14 and col. 12, lines 64 et seq, i.e. a disposable absorbent article/diaper/napkin having a durable hydrophilic fluid pervious fibrous web or substrate with a hydrophilicity boosting composition coated thereon including a hydrophilic boosting amount of nanoparticles having a

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particle size as claimed in claims 1 and 15, the web being a nonwoven polyolefin, e.g. polyethylene, and the nanoparticles being inorganic and a silica/silicate. The claims further claim 1) the substrate being a topsheet of a disposable absorbent article, 2) a specific “hydrophilicity boosting”, see the Claim Language Interpretation section *supra*, and 3) the article further including a storage layer of a particular material or a backsheet and a core between the backsheet and the topsheet. With regard to 1) and 3), see col. 3, lines 28-35 of ‘746, i.e. discloses improving wicking and absorption properties, i.e. hydrophilicity, of conventional absorbent webs in disposable absorbent articles such as diapers and sanitary napkins, and the portions of Aziz and Thompson cited *supra*, e.g. col. 6, lines 11-19 of Thompson, i.e. disposable absorbent articles include storage/core layers of the claimed composition and such between a topsheet and backsheet in which such topsheet includes hydrophilizing surface treatment. Therefore, to make the web of ‘746 a topsheet, if not already, of a disposable absorbent article which also includes a storage layer of the claimed composition between the topsheet and a backsheet as taught by Aziz and Thompson would be obvious to one of ordinary skill in the art in view of the recognition that such structures are conventional layers of disposable absorbent articles and the desire of ‘746 to improve the wicking and absorption of conventional layers in such articles with a hydrophilizing treatment. With regard to 2), it is the Examiner’s first position that since prior art teaches the same compositions of nanoparticles applied to the same substrates in the same manner as that disclosed in the instant application having such “hydrophilicity boosting” capability, there is sufficient factual evidence for one to conclude that the article of the prior art would necessarily and inevitably also have such capability when tested as set forth in the instant application. In any case, at the very least, the prior art teaches a durable

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hydrophilic layer in a disposable absorbent article having a coating thereon of nanoparticles of the claimed size which coating improves the hydrophilicity of the layer, i.e. the same general conditions of the claims are disclosed by the prior art. Therefore, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges, i.e. “hydrophilicity boosting” as claimed, by routine experimentation, see *In re Aller*, 105 USPQ 233.

Claims 13-14 and 16: These claims further claim a high energy treated surface, note MPEP 2113 with regard to claims 13-14, or performing such treatment on the substrate surface, which ‘746 does not teach. However see ‘746 at col. 5, lines 21-33 and ‘926 at col. 12, lines 34-58. Therefore, to also treat the surface of the substrate of ‘746 with high energy treatment as taught by ‘926 such that a treated surface is produced would be obvious to one of ordinary skill in the art in view of the recognition that such would provide a wettable surface in combination with the coating without any surfactant residue or dissolving and the desirability of such by ‘746.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisman et al ‘746 in view of Aziz ‘803 and Thompson ‘926 as applied to claim 6 above, and further in view of the Materials Handbook definition of “Alumina”.

Applicant claims the inorganic nanoparticles being a specific inorganic nanoparticle which is not disclosed by ‘746. However see the definition of “Alumina”, specifically “Aluminum Hydroxide”, i.e. Boehmite alumina is a colloidal nanoparticle used in hydrophilic coatings. Therefore, to make the colloidal nanoparticle of the hydrophilic coating of ‘746 Boehmite alumina instead as claimed would be obvious, see *In re Siebentritt*, 54 CCPA 1083

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(two equivalents are interchangeable for their desired function, express suggestion of desirability of substitution not needed to render such substitution obvious).

16. Claims 1, 8, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young, Sr. et al '000 in view of Early '428 and Zhu '056.

See Claim Language Interpretation section supra and '000 at col. 1, lines 18-21, col. 4, lines 48 et seq, col. 10, lines 47-48, col. 11, lines 46-47, col. 12, lines 2-5, col. 12, line 67-col 13, line 1, col. 13, line 31-35, col. 20, lines 63-66, col. 25, lines 65 et seq, col. 26, lines 23-26 and 43-56, col. 24, lines 53-55, col. 29, line 55-col. 56, line 22, col. 38, lines 63-67, col. 41, lines 12-29 and 66 et seq, i.e. a disposable absorbent article comprising a fibrous web which is a hydrophilic fluid pervious layer or substrate having a hydrophilicity boosting composition coated thereon, i.e. a hydrophilic inorganic binder which is a silica dispersion/liquid, a surfactant and a carrier, e.g. water. Therefore, the '000 reference teaches all the claim limitations except for 1) the layer being a topsheet, 2) the composition including particles which are nanoparticles of the size claimed and 3) the composition being "hydrophilicity boosting" as defined. With regard to 1), layer 216 as disclosed, e.g. at col. 40, lines 4-52 of '000 (Note "may also include" infers "may also not include"), can be the uppermost, i.e. of an absorbent article, i.e. it is considered a "topsheet" layer as claimed. With regard to 2), see Early at col. 1, lines 25-27 and Zhu '056 at col. 4, lines 19-49, i.e. hydrophilic inorganic binders which are silica dispersions/liquids contain colloidal silica of the claimed size. To make the hydrophilic inorganic binder which is a silica dispersion/liquid of '000 one as taught by Early and Zhu, i.e. includes colloidal silica of the size claimed, instead would have been obvious to one of ordinary skill in the art in view of In re Siebentritt, 54 CCPA 1083 (two equivalents are interchangeable for their desired function,

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express suggestion of desirability of substitution not needed to render such substitution obvious).

With regard to 3), it is the Examiner's first position that since prior art teaches the same compositions of nanoparticles applied to the same substrates in the same manner as that disclosed in the instant application having such "hydrophilicity boosting" capability, there is sufficient factual evidence for one to conclude that the article of the prior art would necessarily and inevitably also have such capability when tested as set forth in the instant application. In any case, at the very least, the prior art teaches a durable hydrophilic layer in a disposable absorbent article having a coating thereon of nanoparticles of the claimed size which coating improves the hydrophilicity of the layer, i.e. the same general conditions of the claims are disclosed by the prior art. Therefore, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges, i.e. "hydrophilicity boosting" as claimed, by routine experimentation, see *In re Aller*, 105 USPQ 233.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young, Sr. et al '000 in view of Early '428 and Zhu '056 as applied to claim 8 above, and further in view of Materials Handbook definition of "Detergents".

Applicant claims the surfactant being a nonionic surfactant which '000 does not explicitly set forth. However see '000 at col. 10, lines 47-48 and col. 12, lines 67-68 and the definition of "Detergents", i.e. nonionic agents, i.e. liquid detergents known to be used in textile processing. To make the surfactant of '000 a nonionic surfactant, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such are known detergent surfactants for use in textile processing and the desire of '000 to use a detergent surfactant in its textile processing.

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Due to the large number of patents and applications, i.e. claims involved, the following double patenting rejections will specifically address the rejection of one claim of the instant application and one claim of the patent or other application only with respect to each rejection.

20. Claims 1-5, 12-16 and 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,863,933. Although the conflicting claims are not identical, they are not patentably distinct from each other. Since the instant application has a later effective filing date, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the patent claims? The answer is yes. Claim 15 of the instant application is broader with regard to some aspects and narrower with regard to other aspects of the patent claim 10. With regard to the broader aspects (e.g. patent claims the step of surface treating but the application does not), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the

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broader, i.e. the patented claim anticipates the application claim. See *In re Goodman*, supra.

Note the definition of “coating” bridging pages 3-4 of the application. It is noted that the patent claim 10 claims a topsheet of hydrophilically rendered material capable of absorbing body exudates and including applied nanoparticles. Therefore, such claim is considered to include a process of making a topsheet comprising a hydrophilic fluid pervious acquisition layer having at least some portion coated with a hydrophilicity boosting composition with a hydrophilicity boosting amount of nanoparticles and a particle size of nanometers. With regard to the narrower aspects (e.g. the preamble of the application claims a disposable article, “hydrophilicity boosting” has a specific definition and the nanoparticles are of a specific size), the patent claim teaches a process using nanoparticles of a size which improves the hydrophilicity of the layer, i.e. the same general conditions of the claims are disclosed thereby. Therefore, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges, i.e. “hydrophilicity boosting” and a particle range as claimed, by routine experimentation, see *In re Aller*, 105 USPQ 233. Furthermore, to make the article of claim 10 disposable would have been obvious to one of ordinary skill in the art in view of the recognition that it is well known to make articles which absorb body fluid disposable for any number of reasons including improved hygiene and efficiency of use and the desire of the process to make an article capable of absorbing body fluids.

21. Claims 6-9 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,863,933 in view of Cramer et al ‘569. Claim 17 requires the composition including a surfactant with a carrier which patent claim 10 does not teach. However, see Cramer et al at the claims and col.

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20, line 5-col. 21, line 52, i.e. surfactant which is nonionic alone or in combination with a carrier facilitates dispersion of nanoparticles when such is used on a surface or as a spray. Therefore to employ a surfactant and carrier in combination with the composition of the patent claim 10 as taught by Cramer '569 would have been obvious to one of ordinary skill in the art in view of the recognition that such improves dispersion of a nanoparticle composition on a surface and the desire to disperse such a composition on a surface as set forth in the patent claim.

22. Claims 10-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,863,933 in view of Aziz '803 and Thompson '926. See discussion in paragraph 13 supra.

23. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/758,138 or 10/758,066 in view of Weisman '746, Aziz '803 and Thompson '926.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Since all the applications has the same effective filing date, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the other application claims? The answer is yes. Claim 1 of the instant application is broader with regard to some aspects and narrower with regard to other aspects of the claim 1 of the other applications. With regard to the broader aspects (e.g. the instant application does not require an acquisition layer of an absorbent core or a core wrap surrounding a portion of the storage layer), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e.

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the patented claim anticipates the application claim. See *In re Goodman*, supra. With regard to the narrower aspects (e.g. the instant application claim 1 requires a durable hydrophilic fluid pervious substrate layer which is a topsheet), the claims of the other applications teach disposable absorbent articles which have the hydrophilicity of a layer boosted by the addition of a composition with nanoparticles but such layer is not a topsheet layer as claimed in instant claim 1. However, see '746 at abstract, col. 1, lines 6-20, col. 2, lines 17-23, col. 3, lines 28-35, col. 3, line 67-col. 4, line 44, col. 4, lines 46-62, col. 5, lines 12-15, col. 5, line 34-col. 6, line 43, col. 11, line 62-col. 12, line 14 and col. 12, lines 64 et seq, i.e. a disposable absorbent article/diaper/napkin having a durable hydrophilic fluid pervious fibrous web or substrate with a hydrophilicity boosting composition coated thereon including a hydrophilic boosting amount of nanoparticles having a particle size as claimed in claim 1 to improve wicking and absorption properties, i.e. hydrophilicity, the substrate being conventional layers in such article/diaper/napkin and the portions of Aziz and Thompson cited supra, i.e. disposable absorbent articles conventionally include storage/core layers, acquisition/fluid accepting and transporting/absorption and wicking layers and top sheets which desire absorption and/or wicking capability, i.e. hydrophilicity, e.g. treated to be hydrophilic. To employ a topsheet in the disposable absorbent article of the other application's claim 1 as taught by Aziz, Thompson and Weisman would be obvious to one of ordinary skill in the art in view of the recognition that it is known to use storage/core layers, acquisition/fluid accepting and transporting/absorption and wicking layers and/or top sheets which have the capability to absorb and/or wick, i.e. hydrophilicity, e.g. treated to be hydrophilic, in such disposable articles to maximize absorption.

This is a provisional obviousness-type double patenting rejection.

Common Ownership

24. Claims 1-20 are directed to an invention not patentably distinct from claims of commonly assigned '138, '066, '933 and '569. Specifically, see double patenting rejections *supra*.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned '138, '066, '933 and '569, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Conclusion


25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches various disclosed and claimed features of the instant invention.

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
January 8, 2006